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In re application of :
Guderman et al. : DECISION ON
Serial No. 10/749,876 : PETITION
Filed : December 31, 2003 :
For: RADIATION PATTERNABLE FUNCTIONAL MATERIALS, METHODS OF THEIR
USE, AND STRUCTURES FORMED THEREFROM

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE RESTRICTION REQUIREMENT mailed April 20, 2005 and made final in the office action mailed August 11, 2005.

On April 20, 2005, a seven-way restriction requirement was made by the examiner. The examiner took the position that the groupings of claims I and II, I and V, I and VI, I and VII, II and III, II and IV, II and VI, II and VII, III and IV, III and V, III and VII, IV and V, IV and VI, IV and VII, V and VI, V and VII were each unrelated; I and III, and III and VI are each related as product and process of use; I and IV, II and V, and VI and VII are each related as process of making and product made. Applicants traversed the restriction requirement in a response filed May 19, 2005, and canceled Group VII. The examiner repeated the restriction requirement in an office action mailed August 11, 2005 and made the restriction requirement final. In making the restriction final, the examiner states that the inventions are distinct because different groups are all classified in different areas requiring different searches. The examiner states that the search for a radiation patternable material is different from a simple particle, or the process of forming that particle. The examiner states that the radiation patternable material is not required to be employed in a material or process as other groups are drawn to. Applicants continued to argue the restriction requirement in a response filed December 12, 2005. Applicants further amended the claims to have dependency from claim 1 for each claim. The examiner prepared a final action that was mailed on February 24, 2006 making the art rejection of elected Group I final, and did not respond to applicant's further restriction requirement arguments or amendments regarding such, except to state that despite amendment, the claims stand withdrawn.

On December 12, 2005, the instant petition under 37 CFR 1.181 was filed to formally request the withdrawal of the restriction requirement.

Applicant's position for the withdrawal of the restriction requirement is that the examiner has not shown that the separate groups are independent and distinct.

DECISION

Sections 803 and 806.05(c) of the MPEP state:

803 Restriction - When Proper

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 - § 806.04(i)) or distinct (MPEP § 806.05 - § 806.05(j)) and § 809.03.

806.05(c) Criteria of Distinctness Between Combination and Subcombination

To support a requirement for restriction between combination and subcombination inventions, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., there would be a serious search burden as evidenced by separate classification, status, or field of search. See MPEP § 808.02. The inventions are distinct if it can be shown that a combination as claimed:

(A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and (B) the subcombination can be shown to have utility either by itself or in another materially different combination. When these factors cannot be shown, such inventions are not distinct.

806.05(f) Process of Making and Product Made

A process of making and a product made by the process can be shown to be distinct inventions if either or both of the following can be shown: (A) that the process as claimed is not an obvious process of making the product and the process as claimed can be used to make another materially different product; or (B) that the product as claimed can be made by another materially different process.

Allegations of different processes or products need not be documented.

If applicant convincingly traverses the requirement, the burden shifts to the examiner to document a viable alternative process or product, or withdraw the requirement.

806.05(h) Product and Process of Using

A product and a process of using the product can be shown to be distinct inventions if either or both of the following can be shown: (A) the process of using as claimed can be practiced with another materially different product; or (B) the product as claimed can be used in a materially different process.

Upon review of the initial restriction requirement, the examiner's analysis of Groups I and III as related as product and process of use was flawed. Claim 1 of Group I is drawn to a radiation patternable functional material, while claim 38 of Group III is drawn to a radiation definable ink comprising the material of claim 1 and a solvent. Group III is not directed to a process at all, but rather a composition. Groups I and III are related as combination/subcombination, and as claim 38 requires all the particulars of the subcombination, distinctness cannot be shown. Therefore, Group I as originally restricted should have included claims 1-20, and 38-63.

Groups I and II were restricted as being unrelated. However, applicant amended claim 21 of Group II to be dependent upon claim 1 of Group I in response to the non-final action of August 11, 2005. These claims should now be rejoined with Group I as they can no longer be shown to be distinct inventions. While the restriction between these two groups may have been proper at the outset, the restriction requirement cannot be maintained in light of applicant's amendment. Furthermore, the examiner could have examined the new claims and still made a final rejection as they would have been newly presented claims.

Groups III and VI are indeed related as product and process of use, however, the examiner has not provided rational as to how these two groups are distinct. The examiner merely states that the ink of Group III is not required to be employed in the method of Group IV, and the method of Group VI does not require the use of the ink. According to 806.05(h) to show distinctness, the examiner must show either the process can be practiced with a materially different product, or the product may be used in a different process. The examiner's rational

fails to show either. Since the process is dependent upon the product (ink), it cannot be shown that the process may be performed with a different product. The examiner offered no alternative method in which the ink may be used and the requirement is incomplete.

Groups IV and V are methods of making Groups I and II, respectively. The examiner stated that the process of Group IV is generic and can be employed to prepare many other materials having different composition than that of Group I. Regarding Groups II and V, the examiner merely stated that the compound may be made by employing a different process and the process may be employed to prepare a different product. The examiner has provided no rational or hint of reasoning as to why the process of making the product and the product are independent and distinct. Merely stating that the inventions are independent or distinct because they can be made by a different process or made to form a different product does not properly meet the burden required to show patentable distinction. Therefore, for this reason alone, the restriction requirement is incomplete.

Inasmuch as a restriction requirement may be made, the examiner has not met the burden of showing patentable distinction.

In the response to the traversal of the restriction requirement, the examiner failed to specifically address any of the arguments set forth by Applicant. Instead, the examiner merely restated that the inventions are distinct because different groups are all classified in different areas requiring different searches. In fact, Applicants had set forth clear and persuasive arguments showing why at least some of the requirement was in fact in error. Because the examiner has not shown that the groups of claims are independent and distinct, the restriction requirement is not proper. Accordingly, the petition for withdrawal of the restriction requirement is **GRANTED**.

The application is being forwarded to the examiner to prepare a new office action in light of the withdrawal of the current restriction requirement. If the examiner intends to apply another restriction requirement, they are instructed to provide clear and concise reasoning for how the groupings are independent and distinct according to the MPEP guidelines stated above. Furthermore, at least claims 1-63 should be examined together for reasons outlined above.



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